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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,877	09/20/2000	Daniel J. Mendez	43630.00045	1506

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EXAMINER

GECKIL, MEHMET B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 03/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,877

Applicant(s)

MENDEZ ET AL.

Examiner

Mehmet Geckil

Art Unit

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 83-96 are presented for examination.
2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

Applicant did not teach the details of how the smart phone, a television settop box provided workspace data including the differences as claimed in claims 86 and 93. It would take undue experimentation for one of ordinary skill in the art at the time of the invention to determine the details of the smart phone and a television settop box as claimed in the claims. Smart phones and settop boxes have limited memory resources and applications that are suitable for desktop computers are not suitable for these devices and they have to be optimized specifically for these limited resources devices. Present disclosure lacks such optimization details or any other kind of details showing how applications would be executed in these limited resources devices. For example, U.S. Patent No. 6,212,529, at column 18 lines 64-68 states the following: "If the remote database is located on a handheld computer, R translator manages the memory of the handheld device by limiting the size of the database stored on the handheld computer." Also, applicant on page 23 of the specification stated in a summary fashion that although not shown, other services such as bookmarking may be included in the list. This kind of information is not enabling. The specification is the place where applicant must teach the details of the features of the invention if the applicant wants to claim

such features in the claims. It would take further undue experimentation for one of ordinary skill in the art to determine the details of the bookmark data as claimed in claims 85 and 92. Applicant in the response argued that it was well known that the portable versions of PC based operating systems were being developed, such as Windows CE for running applications on portable devices. This is no more than a speculation. Being developed does not mean it was available at the time of the applicant's filing date. Also, it is the applicant's duty to disclose within the specification, at the time of the filing, such detail information to teach everyone else how to implement their claimed invention on portable devices such as smart phones and settop boxes. Present specification lacks such details and therefore is not enabled for these features. Applicant may delete these features from the claims in order to overcome the first paragraph rejection.

The examiner contends that it would require repeated undue experimentations for one of ordinary skill in the networking art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

3. Claims 85-86 and 92-93 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 83-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salesky et al in view of well known features of the networking art.

7. Salesky et al (6,343,313) taught the invention substantially as claimed including a conferencing system comprising:

a) means for storing first workspace data on a first device (12, col 7 line 35 et seq);

b) means for storing second workspace data on a second device (18, col 8 line 3 et seq);

c) means for determining differences between the first workspace data and the second workspace data (col 7 lines 38-65);

d) means for storing the differences at a global server (col 7 lines 66-67); and

e) means for sending the differences from the global server to the second device (col 8 line 1 et seq.)

8. It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Salesky et al only by a degree. Salesky et al did not mention the word synchronizing as claimed

but this is the essential part of their system. It is well known that in conferencing systems, data displayed on the screen of one of the participants looks the same to another participant on his screen so that they can discuss the relevant merits of the data or data on the whiteboards of the conferencing systems looks the same way to every participant. This looks the same comes to mean that the copy of the data on one screen of one participant is the same copy of the same data as on the screen of another participant. Therefore, they are synchronized. If they are not equal or there is difference between the two copy then they are updated in order to be equal and look the same way. This updating comes to mean synchronization. And Salesky et al taught all about this. Another example for synchronization is the following. For example, a user using a email client logs into an ISP mail server to check his email. The mail program checks the emails on the user's email client program verses the emails on the email server program for that user. And if the program finds that some emails are on the server but not on the user's client email program, the program synchronizes two emails by sending all the emails on the server to the client and thus all the emails will be shown on the users computer. Then it is said that they are in synch with each other or they are synchronized. Examiner will list some patents showing the well known synchronization features under the PTO Form 892. Compaq patent, 5,974,238 is especially looks interesting, e.g. teaching synchronizing a handheld device with a desktop computer or global server.

9. As to claims 84 and 91, the first workspace data comprises a workspace data element from a first user or conferee of the first device to a second user or conferee of the second device (col 7 line 23 et seq.)

10. As to claims 87 and 94, the system further comprised of means for continuing to store the differences at the global server is continued after the sending (col 7 line 25 et seq.)

11. As to claims 88 and 95, the system further comprised of storing at the server version-indication information or time-stamps (col 7 lines 60-65.)

12. As to claims 89 and 96, the system further comprised of means for merging or updating by the second device, the differences with third workspace data stored on the second device (col 8 line 5 et seq.)

13. As to claims 85-86 and 92-93, these features are inherently provided by the teachings of Salesky et al because Salesky et al system was a web based system. Web was invented to provide various services to the users, e.g. email, database, calendar, ftp, html are all essentials of the web based systems. Applicant also on page 23 of the specification stated that although not shown, other services such as bookmarking may be included in the list. Examiner is using the same rational here and saying that these features are inherent part of the web based systems and there may be more to be added to this list of services.

14. It is suggested that in order to advance the application into a successful allowance stage, applicant in response to this office action should overcome first paragraph rejections as well as narrow the scope of the claims substantially by adding new features to the base claims from the specification.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-

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9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mark Powell, can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are listed hereinbelow.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700. Customer service number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7238 (for After final communications);

Or:

(703) 746-7239 (for formal communications intended for entry)

Or:

(703) 746-7240 (for status inquiry or informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

2/25/03

MEHMET B. GECKIL
PRIMARY EXAMINER

